

REMARKS

Claims 1-10 are currently pending in the subject application and are presently under consideration. New claims 11-27 have been added. These amendments are fully supported throughout the specification, and no new matter has been added.¹ Thus, after entry of these amendments, claims 1-27 will be pending in the application.

Favorable reconsideration of the subject patent application is respectfully requested in view of the comments and amendments herein.

I. Rejection of Claims 1-10 Under 35 U.S.C. §102(b)

Claims 1-10 stand rejected under 35 U.S.C. §102(b) as being anticipated by Lioy WO 00/76173 A1.

Applicant respectfully traverses this rejection as the cited reference does not disclose each and every element recited by the claims. For a prior art reference to anticipate, 35 U.S.C. §102 requires that

each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.²

Further:

To establish inherency, the extrinsic evidence ‘must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.’³

Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.⁴

Claims 1-9 recite, *inter alia*, generating a negative acknowledgement message including “supplemental IPCP information instead of an IP address in response to the

¹ See, e.g., paragraphs 0039-0041, 0044, 0049, 0057 and 0058.

² *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999)(quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, USPQ2d 1051, 1053 (Fed. Cir. 1987)).

³ *Id.* (quoting *Continental Can co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991)).

⁴ *Mehl/Biophile Int'l Corp. v. Milgram*, 192 F.3d 1362, 1365, 52 USPQ2d 1303, 1305 (Fed. Cir. 1999), reh'g denied, 1999 U.S. App. LEXIS 31386 (Fed. Cir. Oct. 27, 1999) (quoting *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981)).

requested IP address parameter and deliberately excluding an IP address” in order to extend the protocol synchronization period, “wherein the supplemental IPCP information comprises a type of address different from a potentially valid IP address assignable to the PPP client for establishing a PPP communication link.”

Claim 10 recites, *inter alia*:

triggering the PPP client to generate subsequent configuration request messages comprising the initially-requested IP address based on corresponding negative acknowledgement messages excluding an IP address and including supplemental IPCP information instead of the IP address in order to extend the protocol synchronization period, wherein the supplemental IPCP information comprises a type of address different from a potentially valid IP address assignable to the PPP client for establishing a PPP communication link.

(A) No Disclosure of Including Initially-Requested IP Address in Subsequent Configuration Requests

The Examiner has not provided any recitation of any disclosure by the cited reference of “triggering the PPP client to generate subsequent configuration request messages comprising the initially-requested IP address based on corresponding negative acknowledgement messages excluding an IP address and including supplemental IPCP information instead of the IP address in order to extend the protocol synchronization period,” as recited by claim 10. Further, Applicant submits that the cited reference does not teach or suggest this recited subject matter. As such, the Examiner has not made out a *prima facie* rejection under 35 USC § 102.

Therefore, based on the above remarks, the cited reference does not disclose each and every element recited by claim 10. Thus, Applicant requests that the Examiner withdraw this rejection with respect to claim 10.

(B) No Disclosure of Deliberately Excluding IP Address

The Examiner has not provided any recitation of any disclosure by the cited reference of the negative acknowledgment including supplemental IPCP information instead of an IP address in response to the requested IP address parameter and deliberately excluding an IP address, as recited by claims 1-10.

The “hint values” of the cited reference do not anticipate the above-noted subject matter of claims 1-10, and, in fact, teach away from the recited language.

In particular, the Examiner contends that the disclosure in the cited reference of “hint values” at page 10, lines 29-31, anticipates the recited subject matter. Applicant respectfully disagrees. Specifically, at page 10, lines 30-31, the cited reference discloses “a Configure-Nak comprising hint values.” The Examiner further elaborates on this contention by suggesting that the “request may be for a WINS address or an IP address” and that the “hint values” are “suggested values to request”⁵ for use by the PPP client to request options in a configuration request. As such, the Examiner appears to be arguing that the cited reference teaches that if a PPP client desires an IP address, then the PPP client generates a configuration request having an IP address parameter corresponding to the “hint value” based on the received Configure-Nak.

Accordingly, the disclosed “Configure-Nak comprising hint values” is a departure from the recited subject matter of claims 1-10, which in contrast recite a negative acknowledgement message including supplemental IPCP information instead of an IP address in response to the requested IP address parameter and deliberately excluding an IP address. Instead of returning “hint values” corresponding to “suggested values to request” to obtain an IP address, claims 1-10 contrastingly recite not responding at all to the requested IP address parameter. Instead, according to claims 1-10, the negative acknowledgement message includes supplemental IPCP information that comprises a type of address different from a potentially valid IP address assignable to the PPP client for establishing a PPP communication link. In this respect, rather than responding with an IP address, claims 1-10 recite responding with a different type of address, effectively ignoring the request but extending the protocol synchronization period. As such, the “Configure-Nak comprising hint values” of the cited reference is completely different from the negative acknowledgement recited by claims 1-10. Thus, Applicant respectfully submits that the Examiner has failed to make a *prima facie* rejection of claims 1-10 under 35 USC § 102.

⁵ Advisory Action mailed November 15, 2007, page 3.

Therefore, based on the above remarks, the cited reference does not disclose each and every element recited by the claims. Thus, Applicant requests that the Examiner withdraw this rejection.

(C) Summary

Therefore, based on one or any combination of the above remarks, the cited reference does not disclose each and every element recited by claims 1-10. Thus, Applicant requests that the Examiner withdraw this rejection.

II. New Claims 11-27

As noted above, Applicant has added new claims 11-27 to capture subject matter to which Applicant is entitled. These new claims are fully supported throughout the specification, and no new matter has been added.⁶

Additionally, these new claims are patentable over the cited prior art, as the prior art does not disclose or suggest the recited method or apparatus.

For example, claims 11-13 depend from claim 10, and thus are patentable for at least the same reasons as discussed above. Further, each of these claims presents a combination of subject matter that is separately patentable over the cited reference.

Further, for example, the cited reference does not disclose or suggest a method or apparatus including “transmitting to the PPP client a negative acknowledgment message in response to the IPCP configuration request prior to a completion of the negotiating in order to extend the protocol synchronization period, wherein the transmitting further comprises including, regardless of the requested IPCP parameters, a predetermined address different from a potentially valid IP address assignable to the PPP client for establishing a PPP communication link with the IWF and deliberately omitting an IP address from the negative acknowledgement message,” as recited by claims 14-27.

Thus, Applicant respectfully requests the Examiner to allow new claims 11-27.

⁶ See, e.g., paragraphs 0039-0041, 0044, 0049, 0057 and 0058.

CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 17-0026.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number below.

Respectfully submitted,

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